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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY HAUGLAND and LINDA WOLLSCHLAGER

Appeal 2009-001804
Application 09/513,845¹
Technology Center 2400

Decided: March 16, 2010

Before LEE E. BARRETT, JAY P. LUCAS, and DEBRA K. STEPHENS,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed February 25, 2000. Appellants claim the benefit under 35 U.S.C. § 119 of provisional application 60/122,087, filed February 26, 1999. The real parties in interest are the inventors, Henry Haugland and Linda Wollschlager.

Appellants appeal from a non-final multiple rejection of claims 1 to 33, 42, 43, 45 to 53, 62, and 63 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 34 to 41, 44, 54 to 61, and 64 to 78 are cancelled.

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a technique for inducing potential buyers of goods to visit a seller's website. (*See* claim 1; Spec. 10, ll. 9-16; Spec. 38, ll. 14-19.) Potential buyers and sellers are introduced through a third party, known as a promoter (Spec. 10, ll. 9-12). The promoter manages a database of potential buyer (so-called "contact") names (Spec. 24, ll. 10-11). In the words of Appellants:

According to one technique ... the promoter generates a resource location description for the resource. The resource location description includes a name of the contact. The promoter also provides access to the resource at a location on the network according to the resource location description. The promoter also prepares a message to notify the contact about the resource location description for the resource.

(Spec. 11, ll. 1-6).

Claim 1 is exemplary, and is reproduced below:

1. A method for inducing a contact to invoke a resource prepared by a promoter on a network, the method comprising:

generating a resource location description for the resource by the promoter, the resource location description including a name of the contact;

providing access to the resource at a location on the network according to the resource location description; and

notifying the contact about the resource location description for the resource.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Shane	US 5,793,972	Aug. 11, 1998
LeMole	US 6,009,410	Dec. 28, 1999

REJECTIONS

The Examiner rejects the claims as follows:

- R1: Claims 45 to 53, 62, and 63 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.
- R2: Claims 1 to 5, 7 to 12, 17, 23, 25, 27, 28, 31 to 33, 42, 43, 45 to 48, 51 to 53, 62, and 63 stand rejected under 35 U.S.C. § 103(a) for being obvious over Shane.
- R3: Claims 6, 13 to 16, 18 to 22, 24, 26, 29, 30, 49, and 50 stand rejected under 35 U.S.C. § 103(a) for being obvious over Shane in view of LeMole.

Appellants contend that the claims are drawn to statutory subject matter. (*See* Brief 17, middle.) Appellants further contend that the claimed

subject matter is not rendered obvious by Shane alone, or in combination with LeMole, because Appellants' claim limitation "generating a resource location description ... including a name of the contact" is not disclosed by Shane (Brief 11, top). The Examiner contends that each of the claims is properly rejected (Ans. 19, middle).

The rejections will be reviewed in the order argued by Appellants. The claims are grouped as per Appellants' Brief. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

The issues involve whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 101 and 103(a). The first issue is whether claims 45 to 53, 62, and 63 recite statutory subject matter. The second issue specifically turns on whether Shane's Web page, which includes a personalized advertisement targeting a potential individual buyer of goods, meets Appellants' claim limitation "generating a resource location description ... including a name of the contact" (claim 1).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method of inducing a contact to visit a website where goods and/or services are sold. (*See* claim 1; Spec. 10, ll. 9-16; Spec. 38, ll. 14-19.) The method involves generating a “resource location description” (claim 1), which includes a name of the contact. The purpose of including the contact’s name is to personalize the message for that individual. (*See* Spec. 10, ll. 13-16.)

Shane

2. The Shane reference discloses a method of inducing a potential buyer to visit a website where goods and/or services are sold. (*See* col. 4, ll. 8-14; Figs. 2 and 3; col. 5, ll. 1-11.) The method involves generating a Web page, which includes a name of the potential buyer. The purpose of including the potential buyer’s name is to personalize the message for that individual. (*See* col. 2, ll. 22-27; Figs. 2 and 3; col. 5, ll. 1-11.)

LeMole

3. The LeMole reference discloses customization of advertising for an Internet user. (*See* Abstract.) LeMole discloses that a user’s Web page browsing activity is logged or tracked and advertising “targeting” the user is created based on the user’s profile. (*See* col. 4, ll. 47-56; Ans. 12, top.)

Rule 1.132 Declaration

4. The inventor's declaration attests that better results (16 percent response rate) are obtained when a resource location description that includes the potential buyer's name is used as compared with the situation where no personalized resource location description is employed (1.5 percent response rate). (*See* inventor's declaration filed 10/14/2005, ¶¶ 7, 8.)

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Statutory subject matter

"If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). "A transitory, propagating signal . . . is not a 'process, machine, manufacture, or composition of matter'" under 35 U.S.C. § 101 and therefore does not constitute patentable subject matter under § 101. *Id.* at 1357.

Claim interpretation

Our reviewing court states that "claims must be interpreted as broadly as their terms reasonably allow." *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

Obviousness

Under 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Graham v. John Deere Co., 383 U.S. 1 at 17-18 (1966).

Another secondary consideration for determining nonobviousness is unexpected results. “A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue.” *In re Corkill*, 711 F.2d 1496, 1501 (Fed. Cir. 1985) (citing *United States v. Adams*, 383 U.S. 39, 51-52 (1966)).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.” *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988).

[W]hile an analysis of obviousness always depends on evidence that supports the required Graham factual findings, it also may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion.

Perfect Web Technologies, Inc. v. InfoUSA, Inc., 587 F.3d 1324, 1329 (Fed. Cir. 2009) .

ANALYSIS

From our review of the administrative record, we find that the Examiner presents his conclusions of unpatentability on pages 4 to 13 of the Examiner’s Answer. In opposition, Appellants present several arguments.

*Arguments with respect to the rejection
of claims 45 to 53, 62, and 63
under 35 U.S.C. § 101 [R1]*

Claims 45 to 53, 62, and 63 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Ans. 4, middle).

We treat independent claim 45 as representative of the claims under the rejection [R1]. The Specification discloses that the “computer readable medium” in claim 45 includes “but [is] not limited to, non-volatile media, volatile media,” and, in another example, “[the] communication interface ... [that] sends and receives electrical, electromagnetic or optical signals that

carry digital data streams representing various types of information.” (Spec. 17, l. 24 to Spec. 19, l. 5). Thus, the claims read on transitory signals.

“If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, cited above. “A transitory, propagating signal . . . is not a ‘process, machine, manufacture, or composition of matter’ [under 35 U.S.C. § 101]” and therefore does not constitute patentable subject matter under § 101 (*Id.* at 1357). Claims that are so broad that they read on non-statutory as well as statutory subject matter are unpatentable. Accordingly, claims 45 to 53, 62, and 63 are not patent eligible subject matter.

*Arguments with respect to the rejection
of claims 1 to 5, 7 to 12, 17, 23, 25, 27, 28, 31 to 33,
42, 43, 45 to 48, 51 to 53, 62, and 63
under 35 U.S.C. § 103(a) [R2]*

Claim 1 recites, in relevant part, “generating a resource location description ... including a name of the contact.”

Appellants argue: “The Examiner has made no analysis of ... why it would be ‘obvious’ to use a contact name in lieu of [Shane’s] personal identification code.” (Brief 11, top).

In reply, the Examiner finds that Shane discloses retrieving a contact name via a personal identification code uniquely paired with the contact’s name (Ans. 14, middle to bottom).

We carefully considered the Brief, a Rule 1.132 declaration by one of the inventors, the Answer, and the cited portions of the Shane and LeMole

references, as well as the references as a whole. We agree with the Examiner.

We find that Appellants have invented a method of inducing a contact to visit a website where goods and or services are sold (FF#1). The method involves generating a “resource location description” (claim 1), which includes a name of the contact (*id.*). The purpose of including the contact’s name is to personalize the message for that individual. (*See Spec. 10, ll. 13-16.*) In comparison, we find that the Shane reference discloses a method of inducing a potential buyer (Appellants’ claimed “contact”) to visit a website (Appellants’ claimed “resource”) where goods and or services are sold (FF#2). Shane’s method involves generating a Web page (Appellants’ claimed “resource location description”), which includes a name (Appellants’ claimed “contact name”) of the potential buyer (the claimed “contact”) (*id.*). The purpose of including the potential buyer’s name in Shane’s Web page is to personalize the message for that individual (*i.e.*, the claimed “contact”) (*id.*).

We treat the “resource location description,” as claimed, as being similar to Shane’s Web page for the following reasons. First, we note that Appellants’ claimed “resource location description” is not defined anywhere in the Specification. (*See Spec. 1-45.*) Second, we note that the Specification nowhere discloses that the “resource location description” is the same as a “Universal Resource Locator” (URL). (*See Spec. 43, l. 14 to Spec. 44, l. 24.*) We treat Appellants’ claimed “resource location description” as being broader in scope than a URL. We note that Shane’s system involves inserting the name of a potential buyer (*i.e.*, “a direct mail recipient”) (Abstract) in the Web page for purposes of customizing the page.

(See col. 5, ll. 1-7; Fig. 2.) We read Shane's Web page (element 60), which includes an individual's name (e.g., "Dave Smith," element 50), as meeting the claim limitation "resource location description," because a name (the claimed "name of a contact") is inserted in Shane's Web page (the claimed "resource location description"). Reading the claim language broadly but reasonably, see *In re Zletz*, cited above, the claimed "resource location description" is not merely the "personal identification code" (Col. 5, ll. 1-7; Fig. 2, element 56) associated with the individual's name, but is instead a Web page containing Shane's personal identification code. We thus find unpersuasive Appellants' argument concerning the Examiner's analysis regarding Shane's "personal identification code."

We found above that Shane's Web page 60 as a whole, and not merely Shane's "personal identification code," suffices to meet Appellant's claimed "resource location description," as recited in claim 1. In addition, we find that Appellants' claimed "resource location description" reads on Figure 3 of Shane, in which the direct mail recipient's first name (e.g., "Dave," element 62) is inserted in a unique Web page 60. (See col. 5, ll. 8-11; Fig. 3.) Accordingly, we find no error.

Next, Appellants argue: "As shown by the Declaration attached hereto as Exhibit B, the use of the name in the Uniform Resource Locator, as opposed to some meaningless personal identification code provides significantly improved response rate." (Brief 12, middle).

"Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may

have relevancy.” *Graham v. John Deere Co.*, cited above. Another secondary consideration for determining nonobviousness is unexpected results. “A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue.” *In re Corkill*, cited above.

Appellants have submitted a declaration (filed 10/14/2005) supporting the assertion that the method of claim 1 produces unexpected results that overcome the rejection [R2] under 35 U.S.C. § 103(a). (*See* Brief 12, middle.) More specifically, the inventor’s declaration says that better results (*i.e.*, a 16 percent response rate) are obtained when a resource location description specifying the potential buyer’s name is used compared to the situation where no personalized resource location description is used (*i.e.*, a 1.5 percent response rate is achieved) (FF#4). Although better results (ten times better, according to ¶ 8 of the declaration) may indeed have been obtained, we found above that the argued claim limitation is met by the Shane reference. (*See supra.*) It logically follows that better results are not “unexpected results,” as argued above by Appellants, when the reference discloses what is claimed. In this case, the better results apparently achieved by the claimed “generating” step are not also “unexpected results” that suffice to overcome the rejection under 35 U.S.C. § 103(a). Since we found that Shane discloses “generating a resource location description ... including a name of the contact,” as claimed, we find unpersuasive the inventor’s declaration submitted under Rule 1.132. Accordingly, we find no error in the Examiner’s rejection [R2] of claim 1.

*Arguments with respect to the rejection
of claims 6, 13 to 16, 18 to 22, 24, 26, 29, 30, 49, and 50
under 35 U.S.C. § 103(a) [R3]*

We select claim 6 as representative. Claim 6 incorporates by its dependency Appellants' claim limitation "notifying the contact about the resource location description for the resource" (claim 1).

Appellants contend: "[LeMole does not require notifying] a contact about the resource location description ... since the user has utilized that location to create his profile and must log in to get his pre-specified advertising." (Brief 14, bottom).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, and *In re Merck & Co., Inc.*, cited above.

We are not convinced by Appellants' argument that LeMole fails to disclose Appellants' claimed "notifying" step since LeMole was not cited for the argued feature. (*See* Ans. 12, top.) Rather, the Shane reference was cited for the claimed "notifying" step. (*See* Ans 5, bottom; Ans. 11, bottom.) Accordingly, we find no error.

Appellants further argue: "[T]he Examiner has failed to establish a motivation or suggestion for combining any particular teaching of the LeMole reference with the Shane reference." (Brief 14, bottom to 15, top).

In reply, the Examiner points out that the rationale for combining Shane and LeMole is customizing Web pages for the user (Ans. 12, top). In particular, the Examiner states: "[A] person of ordinary skill in the [art] would have recognized the advantages and desirability of modifying [Shane's] system ... to include the step of logging activity involving the

resource; and changing content in response to the activity logged in order to provide customized pages to the user.” (*Id.*).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l. Co. v. Teleflex Inc.*, cited above.

In accordance with the teachings of *KSR Int’l v. Teleflex*, cited above, the Examiner has stated a rationale (*see supra*) for combining Shane and LeMole. In light of the Supreme Court’s teachings in *KSR* and the Examiner’s articulated rationale, we find unconvincing Appellants’ argument that the Examiner provided no motivation or suggestion for combining the references (Brief 14, bottom to 15, top). Accordingly, we find no error.

Appellants further argue that the Examiner’s use of Official Notice is improper. (*See* Brief 15, top to 16, top.)

In reply, the Examiner maintains that taking Official Notice regarding customization in advertising (*i.e.*, “making changes to the characters or domain to make a URL unique is well known in the art”) is proper. (*See* Ans. 12, bottom and 18, middle.)

Our guiding Court offers the following:

[W]hile an analysis of obviousness always depends on evidence that supports the required Graham factual findings, it also may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion.

Perfect Web Technologies, Inc. v. InfoUSA, Inc., cited above.

We find that the Examiner has applied “common sense” regarding customization of advertising that is in accordance with the teachings of *Perfect Web Technologies*, cited above. Accordingly, we find no error.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 33, 42, 43, 45 to 53, 62, and 63.

DECISION

The Examiner’s rejections of claims 1 to 33, 42, 43, 45 to 53, 62, and 63 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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